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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,128	08/20/2003	Bernd Pahl	PAHL ET AL. -2 (PCT)(DIV)	5325
25889	7590	04/09/2004	EXAMINER	
FONTAINE, MONICA A				
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/644,128	Applicant(s) PAHL ET AL.	
	Examiner Monica A Fontaine	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/857,920.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>082003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The references on the PTO-892 submitted as part of applicant's IDS (filed 08/20/03) should be formally submitted on a PTO 1449 to be considered. Furthermore, the international search report also submitted as part of applicant's IDS (filed 08/20/03) should be listed on a PTO 1449 as a "Non Patent Document" to be considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "great length" is not described in the specification. For purposes of examination, the examiner will interpret "great length" to be a length which is appropriate for the molded article to be usable in industry.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1732

Claims 17, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the UHF channel" in line 3. There is insufficient antecedent basis for this limitation in the claim. Furthermore, acronyms should not be used in a claim without having been clearly defined in the specification and the claim itself.

Claim 17 recites the phrase "pins distributed over the circumference of the roller", and the claim also recites "specifically with formation of beads and closing bridges". It is unclear whether the cited phrases are relative to the roller or the mat. For purposes of examination, it will be assumed that the pins do not necessarily have to relate to the formation of beads and closing bridges on the mat.

Claim 20 recites the term "great length" which is unclear because it is a relative term. The boundary of "great" is not evident, and it is not clear in what way the length is "great".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hetrich (U.S. Patent 3,692,889). Regarding Claim 17, Hetrich shows that it is known to carry out a method of producing tubes characterized by, following extrusion, the tubes are pressed shut within the area

Art Unit: 1732

of the closure with the help of a pressure applicator roller provided with pins distributed over the circumference of the roller (Figure 5; Column 10, lines 1-19); and vulcanization is carried out subsequently (Column 11, lines 41-49).

Regarding Claim 18, Hetrich shows the process as claimed as discussed in the rejection of Claim 17 above, including a method characterized in that exchangeable pins are used (Column 11, lines 37-40; It is noted that the pins are part of the die.).

Regarding Claim 19, Hetrich shows the process as claimed as discussed in the rejection of Claim 17 above, including a method characterized in that the vulcanization is carried out in a hot air installation (Column 11, lines 41-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hetrich, in view of Wolff (U.S. Patent 5,108,690). Hetrich shows the process as claimed as discussed in the rejection of Claim 17 above, but he does not specify a certain length for his flattened molded tubes. Wolff shows that it is known to mold tubular articles characterized in that the tubes are produced with a great length, in conjunction with subsequent cutting of the article depending on the purpose of application (Column 7, lines 37-50). Wolff and Hetrich are combinable because they are concerned with a similar technical field, namely, that of molding processes which yield

Art Unit: 1732

tubular articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Hetrich's tubes to Wolff's specifications in order for Hetrich's tubes to be useful in industry.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. Patent 6,666,940), in view of Hetrich. Regarding Claim 17, Martin et al., hereafter "Martin," show that it is known to carry out a method producing a tube mat, characterized by, following extrusion, the tubes are pressed shut within the area of the closure with the help of a pressure applicator roller (Figure 1, element 40); and vulcanizing is carried out subsequently (Column 5, lines 66-67; Column 6, lines 1-2). Martin does not show using a pressure applicator roller having pins. Hetrich shows that it is known to carry out a method of forming tubes wherein an extruded tube is pressed shut using a roller having pins distributed over the circumference of the roller (Figure 5; Column 10, lines 1-19). Hetrich and Martin are combinable because they are concerned with a similar technical field, namely, that of molding articles having tubular geometry. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hetrich's pressure roller having pins for Martin's pressure roller in order to form a desired pattern on the flattened tube (see Martin, Column 5, lines 38-49).

Regarding Claim 18, Martin shows the process as claimed as discussed in the rejection of Claim 17 above, but he does not show a pressure roller having pins which are exchangeable. Hetrich shows that it is known to carry out a method of forming tubes including a method characterized in that exchangeable pins are used (Column 11, lines 37-40; It is noted that the

Art Unit: 1732

pins are part of the die.). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hetrich's exchangeable pressure roller having pins for Martin's pressure roller in order to form a desired pattern on the flattened tube (see Martin, Column 5, lines 38-49).

Regarding Claim 19, Martin shows the process as claimed as discussed in the rejection of Claim 17 above, including a method characterized in that the vulcanization is carried out in a hot air installation (Column 5, lines 66-67; Column 6, lines 1-2), meeting applicant's claim.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Hetrich as applied to claim 17 above, and further in view of Wolff. Martin shows the process as claimed as discussed in the rejection of Claim 17 above, but he does not specify a certain length for his flattened molded tubes. Wolff shows that it is known to mold tubular articles characterized in that the tubes are produced with a great length, in conjunction with subsequent cutting of the article depending on the purpose of application (Column 7, lines 37-50). Wolff and Martin are combinable because they are concerned with a similar technical field, namely, that of molding processes which yield tubular articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Martin's and Hetrich's tubes to Wolff's specifications in order for Martin's and Hetrich's tubes to be useful in industry.

Conclusion

Art Unit: 1732

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to methods of forming tubular articles in general:

U.S. Patent 4,395,459 to Herschdorfer et al.

U.S. Patent 5,911,939 to Jenkins

U.S. Patent 5,837,077 to Kabe et al.

U.S. Patent 6,579,401 to Izuchukwu et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A Fontaine whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianne can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maf
March 24, 2004



MICHAEL COLAIANNI
PRIMARY EXAMINER